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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,113	12/20/2001	Kenneth Ouriel	CCF-5814	3220

26294 7590 05/04/2005

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EXAMINER
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THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/028,113

Applicant(s)

OURIEL ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 76-90 and 96-103 is/are pending in the application.
- 4a) Of the above claim(s) 98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 76-90, 96, 97 and 99-103 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

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Claim 98 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 10, 2005. Contrary to applicant's remarks, claim 98 reads on the species of figures 10A to 10D rather than the elected species of figures 9A and 9B.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 83, 96, 97, 99 and 100 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In claim 83, phrases such as "which engage an inner side surface of a first blood vessel" in lines 4-5 define the blood vessel (which is part of the human body) as part of the claimed combination. The human body is non-statutory subject matter. Claim 96 is rejected for the same reason.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 83 and 97 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the limitation from the phrase "said stent" in claim 83, line 6 to the end of the claim. There is no basis in the original disclosure for the limitation from the phrase "said stent" in claim 97, line 7 to the end of the claim.

Claims 76-97 and 99-103 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 76, lines 4-5 are confusing and inaccurate since the inner layer of fabric does not define an outer side of the trunk portion. Further, the trunk portion is defined as including an inner layer of fabric in lines 4-5. Therefore, it is not seen how this inner layer of fabric (which is part of the trunk portion) can also partially define the branch lumens as defined in lines 11-12 since the same material cannot be in both places at the same time. Further, it is unclear if this limitation is meant to

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mean that the inner layer of the branch lumens is unitary with or formed of exactly the same material as the inner layer of the trunk portion or both. Claim 101 is indefinite for the same reasons. The scope of claims 83 and 96, 97, 99 and 100 is unclear for the reasons set forth in the rejection above based upon 35 U.S.C. 101.

Claims 76-79, 81-86 and 88-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,099,558) in view of Banas et al. (6,004,348). White et al. disclose an endovascular prosthesis comprising trunk portion (the main portion of graft 10 shown in figures 1 and 7i, for example), a radially expandable support 17 and furcated portion 19a, 19b. White et al. fail to disclose the prosthesis having inner and outer layers. However, Banas et al. teach that an endovascular prosthesis should have an inner layer 24 and an outer layer 26 with the radially expandable support 22 disposed between the layers in order to obtain the advantage of facilitating non-turbulent fluid flow through the lumen of the prosthesis (col. 12, lines 31-42 and col. 13, lines 19-32). It would have been obvious to form the White et al. prosthesis of inner and outer layers and to position the radially expandable support 17 between these layers so that it too would have this advantage. As to claim 77, note col. 12, lines 43-53 of Banas et al. As to

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claim 81, note outflow limbs 10a, 10b of White et al. As to claim 83, White et al. disclose stent 17a. As to claim 84, White et al. fail to disclose sutures connected to branches 19a, 19b. However, it is old and well known to use sutures to secure parts of an endoprosthesis together in order to obtain the advantage of insuring that the parts do not separate. It would have been obvious to connect sutures to the White et al. branches 19a, 19b to secure parts 10a, 10b thereto so that it too would have this advantage.

Claims 80 and 101-103 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,099,558) in view of Banas et al. (6,004,348) as applied to claim 76 above, and further in view of Richter et al. (6,090,133). White et al. fail to disclose the trunk portion formed by a number of sections equal to the number of branches wherein the sections are interconnected by seams. However, Richter et al. teach that a bifurcated prosthesis should be so formed (col. 4, line 47 to col. 5, line 37 and noting seams 92 in figure 11), apparently in order to obtain the advantage of easily manufacturing and assembling a bifurcated member. It would have been obvious to form the White et al. trunk portion of a number of sections equal to the number of branches so that it too would have this advantage.

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Claim 87 is rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,099,558) in view of Banas et al. (6,004,348) as applied to claim 76 above, and further in view of Pinheiro (5,851,228). White et al. fail to disclose a rod in each of the branches 19a, 19b. However, Pinheiro teaches that rods 49 should be located in branches 91a, 91b in order to obtain the advantage of providing additional radial support of the branches (col. 6, lines 2-9). It would have been obvious to include rods in the White et al. branches 19a, 19b so that it too would have this advantage.

Claims 96 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,099,558) in view of Evans et al. (6,102,938). White et al. fail to disclose at least four branches. However, Evans et al. teach that there can be at least four branches in a bifurcated endoluminal prosthesis apparently in order to obtain the advantage of permitting at least four side blood vessels to be connected to the main blood vessel (col. 4, lines 29-36). It would have been obvious to include at least four branches in the White et al. bifurcated endoluminal prosthesis so that it too would have this advantage.

Claims 99 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (6,099,558) in view of Evans et al. (6,102,938) as applied to claim 96 above, and

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further in view of Banas et al. (6,004,348) for the reasons set forth above.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note col. 14, lines 50-51 of Alcime et al. (5,632,772).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

mht  
4/28/05



MICHAEL THALER  
PRIMARY EXAMINER  
ART UNIT 3731